

Appl. No. : 09/883,625
Filed : June 18, 2001

REMARKS

Applicant has reviewed the final Office Action mailed on March 14, 2006, and has considered the statements of the Examiner during the telephonic interview on April 13, 2006, and the additional remarks provided in the Advisory Action mailed on June 7, 2006. These remarks are responsive thereto. Claims 17-19 and 21-31 remain pending in this application. Claims 1-16 and 20 have been canceled, without prejudice. Claims 17-19 and 21-23 have been amended. Claims 24-31 have been added.

Discussion of Claim Rejections under 35 U.S.C. § 102

Claims 4-5, 8, 15, 18, 20, and 22 stand rejected under 35 U.S.C. § 102(a), (e) as being anticipated by Robinson et al., U.S. Pat. No. 5,915,022 ("Robinson"). Claims 4-5, 8, 15, and 20 have been canceled, thereby rendering their rejections moot. With respect to the rejections of the remaining Claims 18 and 22, Applicant respectfully traverses the rejection.

The Law of Anticipation

Anticipation under Section 102 can be found only if a reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775 (Fed. Cir. 1985). More particularly, a finding of anticipation requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention. *Electro Med. Sys. S.A. v. Cooper Life Sciences*, 34 F.3d 1048, 1052 (Fed. Cir. 1994). "To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim." *Brown v. 3M*, 265 F.3d 1349 (Fed. Cir. 2001). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). Although the express, implicit, and inherent disclosures of a prior art reference may be relied upon in rejecting claims under section 102, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. MPEP 2112; *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993). Moreover, "the missing descriptive matter [must be] necessarily present in the thing described in the reference." *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999).

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Claim 18

Claim 18 recites (emphasis added):

A method of a third party authenticating a transaction conducted between a first party and a second party, the method comprising:
receiving, by a third party, a transaction certificate with an encrypted code;
retrieving a public key of the first party;
decrypting the encrypted code based on the retrieved public key of the first party to generate decrypted proof elements; and
declaring the transaction between a first party and a second party including the decrypted proof elements as authenticated if the decrypting is successful.

The final Office Action did not accord patentable weight to the recitation of the third party because, according to the final Office Action, the recitation of the third party occurs only in the preamble. As is apparent from the emphasized portion of the claim above, the third party recitation is not limited to the preamble, is in the body of the claim, and should therefore be accorded patentable weight during examination. Applicant submits that Robinson fails to teach or otherwise suggest at least "receiving, by a third party, a transaction certificate with an encrypted code" as recited in the claim. In fact, Robinson makes no mention whatsoever of a third party participating in a transaction in any respect, much less the text of the claim. Accordingly, as Robinson does not teach each feature recited in the claim, Applicant respectfully submits that the outstanding rejection should be withdrawn.

Claim 22

Claim 22 also stands rejected as being anticipated by Robinson. Claim 22 as amended recites (emphasis added):

A computing device for verifying, by a third party, a transaction conducted between a first party and a second party, the device comprising:
a receiving module configured to receive a hard copy transaction certificate including an encrypted code;
a scanning module configured to scan the received hard copy transaction certificate into electronic form;
a retrieving module configured to retrieve a public key of the first party;

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a decrypting module configured to decrypt the scanned encrypted code based on the retrieved public key of the first party to generate decrypted proof elements; and

a declaring module configured to declare, on behalf of the third party, the transaction including the decrypted proof elements as authenticated if the decrypting is successful.

Applicant respectfully submits that the Claim 22, as amended, overcomes the rejection for substantially the same reasons as Claim 18 described above. In particular, Claim 22 includes a “declaring module configured to declare, on behalf of the third party, the transaction ... as authenticated....” As noted above, Robinson does not provide any disclosure of third party involvement in authenticating a transaction. Accordingly, Applicant respectfully submits that Claim 22 is also allowable over Robinson.

Discussion of Rejections Under 35 U.S.C. § 103(a)

Claims 1-3, 6-7, 11-14, and 17 and rejected under 35 U.S.C. § 103(a) as being unpatentable over Robinson in view of Zhao et al., U.S. Pat. No. 6,243,480 (“Zhao”). Applicant has canceled Claims 1-3, 6-7, and 11-14, thereby rendering these rejections moot. Claim 17 remains pending, and has been amended to more clearly recite the role of the third party in the claimed process.

Claim 17

The final Office Action states that Claim 17 is unpatentable over Robinson in view of Zhao. The Examiner concedes that Robinson does not disclose printing at least a portion of the received transaction elements on a hardcopy transaction certificate, nor does it disclose printing the encrypted code on the hardcopy transaction certificate and instructing the second party to scan the transaction certificate to convert the encrypted code to electronic form. The Office Action relies on Zhao stating that Zhao teaches receiving a hardcopy of a document with partial authentication information and scanning the analog reference to convert the encrypted code into an electronic form for verification, at column 3, line 57 – column 4, line 14. According to the Office Action, it would have been obvious to one of ordinary skill in the art to print out a hardcopy of the transaction receipt to be scanned in at a later time to verify a transaction. As Zhao states, at column 3, lines 41-54, that such a modification would provide a way to

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authenticate a digital receipt that has been printed out without losing the authentication information.

Claim 17 recites (emphasis added):

A method of a third party authenticating a transaction conducted between a first party and a second party, the method comprising:

receiving, by a third party, a hard copy transaction certificate with an encrypted code;

scanning the received transaction certificate to convert the encrypted code into electronic form;

retrieving a public key of the first party;

decrypting the converted encrypted code based on the retrieved public key of the first party to generate decrypted proof elements; and

declaring the transaction between a first party and a second party including the decrypted proof elements as authenticated by the third party if the decrypting is successful.

Applicant respectfully submits that Claim 17 is allowable over the combination of Zhao and Robinson for substantially the same reasons as discussed above. Specifically, neither Zhao nor Robinson teach or suggest third party authentication. As a result, the combination of Zhao and Robinson, even if proper, fails to teach or suggest at least the features of “receiving, by a third party, a hard copy transaction certificate with an encrypted code” and “declaring the transaction between a first party and a second party including the decrypted proof elements as authenticated by the third party if the decrypting is successful” as recited in Claim 17. Accordingly, Applicant respectfully submits that Claim 17 is allowable.

Claims 9, 10, 16, 19, 21, and 23

Claims 9, 10, 16, 19, 21, and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Robinson in view of Powar, U.S. Pat. No. 6,285,991 (Powar). Applicant has canceled Claims 9, 10, and 16, thereby rendering these rejections moot. Amended Claims 19, 21 and 23 each include recitations of third party authentication similar to those described above in connection with Claims 18 and 22. Neither Robinson nor Powar, alone or in combination, provides any teaching of third party authentication as recited in the claims. Thus, Applicant respectfully submits Claims 19, 21 and 23 are allowable.

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New Claims

Claims 24-31 have been added. Each of these claims depends either directly or indirectly on one of the above-discussed independent claims. Applicant respectfully submits that pursuant to 35 U.S.C. § 112, ¶ 4, the dependent claims incorporate by reference all the limitations of the claim to which they refer and include their own patentable features, and are therefore in condition for allowance. Therefore, Applicant respectfully requests the withdrawal of all claim rejections and prompt allowance of the claims.

CONCLUSION

In light of the above, reconsideration and withdrawal of the outstanding rejections are specifically requested. In view of the foregoing remarks, Applicant respectfully submits that the claims of the above-identified application are in condition for allowance. However, if the Examiner finds any impediment to allowing all claims that can be resolved by telephone, the Examiner is respectfully requested to call the undersigned.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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Dated: _____

7/14/06

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